



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,090	12/14/1999	AXEL ULLRICH	P564-9051	3321

7590

03/27/2002

ARENT FOX KINTNER PLOTKIN & KAHN, PLLC
1050 CONNECTICUT AVENUE
SUITE 600
WASHINGTON, DC 20036-5339

EXAMINER

LU, FRANK WEI MIN

ART UNIT	PAPER NUMBER
----------	--------------

1634

DATE MAILED: 03/27/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/461,090

Applicant(s)

ULLRICH ET AL.

Examiner

Frank Lu

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 February 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: _____.
3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.


CHANTAE DESSAU
PATENT ANALYST

Frank Lu
Examiner
Art Unit: 1634

Art Unit: 1634

ADVISORY ACTION

1. The purposed amendments filed on February 19, 2002 have been fully considered but will not be entered because they raise new issues that would require further consideration and/or search.

The phrase “with a compound effecting a proteinase and/or a ligand precursor for the growth-factor receptor” in claim 1 raises new issues that would require further consideration and/or search. First, it is unclear how a compound effecting any kind of proteinase can modulating growth-factor receptor activation. It was known that not every proteinase was related to growth-factor receptor activation. Second, the examiner noted that, in the amendment filed on March 6, 2001, independent claim 1 did not require to activate a growth-factor receptor by a modulator of G-protein mediated signal transduction and phrase “capable of being activated with a modulator of G-protein mediated signal transduction” was only optional while new added claim 1 filed on February 19, 2002 absolutely required contacting a cell or an organism with a compound effecting a proteinase and/or a ligand precursor for the growth-factor receptor, which was a modulator of G-protein mediated signal transduction. Although the limitations of a proteinase that cleaves a ligand precursor for the growth-factor receptor could be found in dependent original claim 9, this limitation was only optional in original filed claim 9.

The phrase “by G-protein mediated signal transduction” in claim 17 raises new issues that would require further consideration and/or search because “G-protein mediated signal transduction” was optional in the amendment filed on March 6, 2001. However, new amended claim 17 absolutely required “G-protein mediated signal transduction”.

Art Unit: 1634

The phrase “a growth-factor receptor capable of activation by G-protein mediated signal transduction” and the phrase “a modulator of a proteinase or a ligand precursor of the growth factor receptor” raise new issues that would require further consideration and/or search. First, the phrase “a growth-factor receptor capable of being activated with a test compound suspected to be a modulator of G-protein mediated signal transduction” in claim 20 filed on March 6, 2001 was not equal to the phrase “growth-factor receptor capable of activation by G-protein mediated signal transduction” in new amended claim 20 since the phrase “a growth-factor receptor capable of being activated with a test compound suspected to be a modulator of G-protein mediated signal transduction” did not mean that a growth-factor receptor was activated by G-protein mediated signal transduction but only suggested that a test compound had a potential to be a modulator of G-protein mediated signal transduction. Second, it is unclear how a compound effecting any kind of proteinase can modulating growth-factor receptor activation. It was known that not every proteinase was related to growth-factor receptor activation.

Response to Arguments

Applicant's arguments with respect to claims 1-21 have been considered but are moot. However, the purposed amendments will not be entered since they raise new issues that would require further consideration and/or search (see above).

3. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94

Art Unit: 1634


(December 28, 1993)(See 37 CFR § 1.6(d)). The CM Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (703) 305-1270. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the patent Analyst of the Art Unit, Ms. Chantae Dessau, whose telephone number is (703) 605-01237.

Frank Lu
March 12, 2002


ETHAN C. WHISENANT
PRIMARY EXAMINER